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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,441	03/16/2004	Joseph P. Orban III	2775 (203-3094)	1999

7590

01/26/2005

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EXAMINER

FLANAGAN, BEVERLY MEINDL

ART UNIT PAPER NUMBER

3739

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/801,441	ORBAN, JOSEPH P.	
	Examiner	Art Unit	
	Beverly M. Flanagan	3739	

-- **Th MAILING DATE of this communication app ars on th cover sheet with the correspond nce address --**  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 and 9 is/are allowed.
- 6) ☒ Claim(s) 1 and 7 is/are rejected.
- 7) ☒ Claim(s) 2-6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

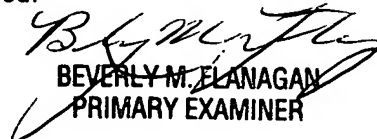
#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**BEVERLY M. FLANAGAN**  
**PRIMARY EXAMINER**

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/19/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement filed July 19, 2004 has been made of record and the references cited therein have been considered by the examiner.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graber (U.S. Patent No. 5,190,561) in view of Zimmon (U.S. Patent No. 5,782,747).

**In regard to claims 1 and 7**, Graber teaches a tissue and organ extractor 10 comprised of hollow shank 26 with a cone-shaped terminal end 28 that includes a cable 82 that acts as a support member for the end 28 (see Figures 1 and 2). Cable 82 forms a generally circular circumference at the mouth 84 of end 28 and web 72 forms a pouch having first and second ends and defining a container therein for retaining the tissue specimen (see Figure 2). The web 72 is moved from a collapsed position with a trocar sleeve 14 to an extended, tissue receiving position by raising and lowering ring 27 over web 62 by activating handle 24 and locking lever 36 (see Figure 9). Graber is silent as to the use of the extractor 10 within the lumen of an endoscope. However, Zimmon discloses a similar tissue grasping device 11 that is positioned within the lumen 14 of an

endoscope 10 (see Figure 2a). Zimmon thus demonstrates that the use of tissue grasping devices as passed down the lumen of an endoscope is well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to utilize the extractor 10 of Graber with an endoscope, in the manner disclosed by Zimmon.

***Allowable Subject Matter***

Claims 2-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 8 and 9 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach or fairly suggest a device or method as recited in claims 8 and 9 of the instant invention, specifically, a device having first and second hoop-like support members with a pouch extending between the first and second hoop-like members. Numerous prior art references teach a pouch or pouch-like tissue retrieval device with a first support members, usually at the distal end of the pouch (see e.g., Keiturakis, U.S. Patent No. 5,643,282; McGuckin, Jr., U.S. Patent No. and Fawzi et al., U.S. Patent No. 6,471,709). However, none of the references teach both a first and second support member with the pouch therebetween. Accordingly, claims 8 and 9 are allowable over the prior art.

### ***Conclusion***

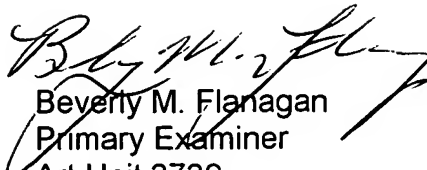
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant should note the following examples of tissue removal devices having a pouch and a first supporting member: McGuckin, Jr., U.S. Patent No. 6,589,252; Fawzi et al., U.S. Patent No. 6,471,709; and Bates et al., U.S. Patent Application Publication No. 2003/0120281.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beverly M. Flanagan whose telephone number is (571) 272-4766. The examiner can normally be reached on Mondays, Wednesdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 3739

  
Beverly M. Flanagan  
Primary Examiner  
Art Unit 3739

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